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EXAMINER

ENGLE, PATRICIA LYNN

ART UNIT

PAPER NUMBER

3612

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/700,165

Applicant(s)

BRAUER ET AL

Examiner

Patricia L Engle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/3/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to because they are informal drawings. Formal drawings should be submitted in response to this Office Action. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Morimanno, Sr. et al. (US Patent 5,165,707).

Regarding claim 1, Morimanno, Sr. et al. disclose a headache rack (33) for a pickup truck comprising: a rack frame (25,29), the frame (23) being adjustable in height (title) to accommodate pickup trucks of different heights (This is an intended use limitation- A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the

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claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).); and a rack mounting (Fig. 1) provided on the frame (23) for mounting the frame to a pickup truck (13).

Regarding claim 2, Morimanno, Sr. et al. disclose the headache rack of claim 1 wherein the rack frame (23) includes an upper frame section (29) and a lower frame section (25), the upper frame section (29) capable of telescoping with respect to the lower frame section (25) in order to adjust the height of the rack.

Regarding claim 3, Morimanno, Sr. et al. disclose the headache rack of claim 2 further comprising a pair of tubular members (25) that are attached to the lower frame section (25), the upper frame section (29) mating with tubular members (25) in a telescoping manner in order to adjust the height of the rack.

Regarding claim 5, Morimanno, Sr. et al. disclose the headache rack of claim 3 wherein the upper frame section (29) includes a pair of upstanding members (29), the upstanding members (29) of the upper frame section mating with the tubular members (25) in a telescoping manner in order to adjust the height of the rack.

4. Claims 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Finneyfrock (US Patent 5,258,893).

Regarding claim 8, Finneyfrock discloses a headache rack for a pickup truck comprising: a rack frame (18), the frame including internal wiring pathways (Fig. 3a) for running wiring from any electrical devices (42) mounted on the rack (16) to a power source in order to protect the

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wiring (Fig. 3a) from the elements; and a rack mounting (32) provided on the frame for mounting the frame to a pickup truck.

Regarding claims 9 and 18, Finneyfrock discloses the headache rack of claim 8 further including at least one access hole (inherent) through which the wiring may enter the rack (18,16).

Regarding claim 10, Finneyfrock discloses the headache rack of claim 8 further including at least one access hole (54) through which the wiring may exit the rack (16).

Regarding claim 11, Finneyfrock discloses the headache rack of claim 8 further including a plurality of snap bushings (50) installed internally to protect the wiring.

Regarding claim 12, Finneyfrock discloses the headache rack of claim 8 wherein the rack includes a lower frame section (18) and an upper frame section (16) mounted to the lower frame section, the wiring pathways provided through the upper frame section and the lower frame section of the rack (inherent to the fact that there are electrical devices on the lower frame sections and the upper frame section).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 4, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morimanno, Sr. et al. in view of Lane (US Patent 6,698,810, filed on September 23, 2002).

Regarding claims 4, 6 and 7, Morimanno, Sr. et al. do not disclose that the lower frame section includes a pair of upstanding members wherein the tubular members are attached to the upstanding members (claim 4) or that the extendable member is held in place by a plurality of holes and a fastener (claims 6 and 7).

Lane discloses an extendable member for a truck bed in which the lower frame member (10) includes tubular members (2C) mounted to the lower frame section and upstanding members (2B) attached to the tubular members and a plurality of holes (4A) formed in the upstanding members (2A) of the upper frame section and a plurality of holes on the respective tubular members (column 7, lines 66-67) with a fastener (column 8, lines 2-6) locking the members in the desired height. Lane also discloses in column 8, lines 25-28 that the manual operation of the rack is a substitute for electric or hydraulic operation.

Lane and Morimanno, Sr. et al. are analogous art because they are from the same field of endeavor, i.e., vertically extendable racks for vehicles.

It would have been obvious to one of ordinary skill in the art to make the rack of Morimanno, Sr. et al. manually operated and locked in place with aligning holes and a fastener (claims 6 and 7) and it would have been obvious to use an upstanding member mounted to the

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tubular member of the lower frame section. The motivation would have been to allow the rack to have a large variety of heights without requiring the lower frame section to be extremely tall.

Therefore, it would have been obvious to combine Lane with Morimanno, Sr. to obtain the invention as specified in claims 4, 6 and 7.

8. Claims 8, 12, 13, 15, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morimanno, Sr. et al. in view of Fineyfrook.

Morimanno, Sr. et al. disclose disclose a headache rack (33) for a pickup truck comprising: a rack frame (25,29), the frame (23) being adjustable in height (title) to accommodate pickup trucks of different heights (This is an intended use limitation- A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).); and a rack mounting (Fig. 1) provided on the frame (23) for mounting the frame to a pickup truck (13). Regarding claim 13, Morimanno, Sr. et al. disclose the headache rack wherein the rack frame (23) includes an upper frame section (29) and a lower frame section (25), the upper frame section (29) capable of telescoping with respect to the lower frame section (25) in order to adjust the height of the rack. Regarding claim 15, Morimanno, Sr. et al. disclose the headache rack wherein the upper frame section (29) includes a pair of upstanding members (29), the upstanding members (29) of the upper frame section mating with the tubular members (25) in a telescoping manner in order to adjust the height of the

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rack. Regarding claim 16, Morimanno, Sr. et al. discloses that the upper ends of upstanding members of the upper frame section are closed. Morimanno, Sr. et al. also disclose that the rack includes electrical components.

Morimanno et al. do not disclose that the wiring for the electrical components (39) is mounted through the frame members.

Finneyfrock disclose a rack for pickup truck with electrical components mounted on the rack and the wiring for the electrical components is connected to the electrical component through the frame members.

Morimanno, Sr. et al. and Finneyfrock are analogous art because they are from the same field of endeavor, i.e., racks for pickup trucks.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to mount the wiring through the frame members.

The motivation would have been to protect the wiring from the weather, the loads being carried in the pickup truck and to make the appearance of the rack cleaner than if the wiring were mounted outside the frames.

Therefore, it would have been obvious to combine Finneyfrock with Morimanno, Sr. et al. to obtain the invention as specified in claims 8, 12, 13, 15, 16.

Regarding claim 17, it would have been obvious to one of ordinary skill in the art to include an access opening in the upper tubular member. The motivation would have been to get the wiring from the lower member to the electrical component.


Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art discloses other lighting structures on pickup truck racks and other extendable pickup truck racks.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L Engle whose telephone number is (703) 306-5777. The examiner can normally be reached on Monday - Friday from 8:00 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Glenn Dayoan can be reached on (703) 308-3102. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patricia L Engle
Examiner
Art Unit 3612

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May 4, 2004